APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,756	01/04/2001	Marshall Wayne Thomas	13DV13543	3774

			EXAMINER
31852	7590	05/04/2004	GARCIA OTERO, EDUARDO

BARBARA JOAN HAUSHALTER
LAW OFFICE
228 BENT PINES CT.
BELLEFONTAINE, OH 43311

ART UNIT	PAPER NUMBER
2123	5

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| **Office Action Summary** | **Application No.** 09/754,756 | **Applicant(s)** THOMAS, MARSHALL WAYNE |
| | **Examiner** Eduardo Garcia-Otero | **Art Unit** 2123 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *4 Jan 2001* .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>04 January 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

U.S. Patent and Trademark Office

PTO-326 (Rev. 04-01)   Office Action Summary   Part of Paper No. 5

DETAILED ACTION-First Action on Merits

Examined

1. **Claims 1-18** have been submitted, examined, and rejected.

Claim Rejections - 35 USC § 101-not patentable invention

2. **35 U.S.C. 101 Inventions patentable** reads as follows:

3.   Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
     any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
     requirements of this title.

4. **Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is not a patentable invention.**

5. First, consider the case law and the MPEP. In re Venner, 262 F.2d 91, 95, 120 USPQ 192, 194 (CCPA 1958) states "it is well settled that **it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result.**" Additionally, MPEP 2144.04(III) states "broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art." The Examiner notes that the specification provides little substantive detail. And the Examiner further notes that the claims are all rejected under 35 U.S.C. 112 first paragraph (below).

6. Second, note that the **specification admits that the claimed invention is merely "automating" the "manual" comparison process.** The specification on Page 2 line 26 admits "It is **typical for corporations to have established guidelines** for the design of products and parts, particularly when safety is an issue", and Page 3 line 25 admits "Engineering calculation of proposed designs are then **manually compared** with the

design practice limits to insure compliance with those limits", and Page 4 line 2 admits

"The present invention proposes **automating the comparison process**".

7. Third, note that Applicant's **"own admission during prosecution...is binding upon**

him" according to Constant v. Advanced Micro-Devices, 848 F2d 1560, 1570, 7

USPQ2d 1057, 1063 (Fed. Cir. 1988).

8. **In conclusion, by Applicant's binding admission in the specification, the claimed**

invention is merely automating a manual process, and therefore is not a patentable

invention under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112- first paragraph- description

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claim 1-18 are rejected under 35 U.S.C. 112, first paragraph,** as containing subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention.

11. **Specifically, Claim 1 states "applying the analysis algorithm to perform calculations**

to generate an analysis output". The specification does not adequately describe this

limitation. For example, Page 4 line 12 states "This incorporates the design practice

limits as a computer input, to interact with additional inputs such as the operating

environment parameters". There is not adequate description of "interact". Claims 2-9

inherit this defect and are similarly rejected.

12. **Specifically, Claim 10 states "an analysis algorithm for comparing the input file with design criteria to generate an output".**

13. The specification does not adequately describe this limitation. For example, Page 3 line 14 states "The design criteria are typically created during previous design processes, to incorporate "best practices" as well as "lessons learned" from the previous design projects". There is not adequate description of "best practices" or "lessons learned". Claims 11-18 inherit this defect and are similarly rejected.

Claim Rejections - 35 USC § 102(e)

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

15. A person shall be entitled to a patent unless –

16. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

17. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

18. **Claims 1-18 are rejected under 35 U.S.C. 102(e)**

19. **Claim 1 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido et al. US Patent 6,243,835 B1, which will be referred to as Enokido. Claim 1 is an independent claim with 5 limitations.

20. **"limits into an input file"** is disclosed by Enokido at FIG 1 element 9 "DESIGN

TABLES".

21. **"input file into an analyses algorithm"** is disclosed by Enokido at FIG 1 element 2

"DESIGN INFORMATION READING MEANS".

22. **"calculations to generate an analyses output"** is disclosed by Enokido at FIG 1

element 4 "DATA ANALYSIS MEANS"

23. **"compare the analyses output to the limits to generate a design output"** is disclosed

by Enokido at FIG 1 element 6 "FIRST TEST ITEM GENERATION MEANS".

24. **"issue an alert"** is disclosed by Enokido at FIG 1 element 8 "TEST SPECIFICATION

WRITING MEANS".

25. Additionally, note that Enokido Column 1 line 39 states "A typical known testing tool of

this kind, for instance, is "SQA suite (registered trademark o SQA Inc. in the United

States)". This tool manages a whole sequence of software testing processes from test

planning/design to generation of a report on test results."

26. **ALTERNATE REJECTION: Claim 1 is alternately rejected under 35 U.S.C. 102(e)**

as being anticipated by Mitchell US Patent 6,323,774 B1, which will be referred to as

Mitchell. Claim 1 is an independent claim with 5 limitations.

27. **"limits into an input file"** is disclosed by Mitchell at abstract "processor that includes a

program for setting threshold values"

28. **"input file into an analyses algorithm"** is disclosed by Mitchell at abstract ""processor

that includes a program for setting threshold values of water volume per unit time

anticipated by the particular household"

29. **"calculations to generate an analyses output"** is disclosed by Mitchell at abstract

"system is programmed in volume increments of time such as hours, days, or weeks to

accommodate systems that include sprinklers which may require some volume of water

over a short period of time".

30. **"compare the analyses output to the limits to generate a design output"** is disclosed

by Mitchell at abstract "the threshold value of the system could be

preprogrammed...which if exceeded would set off the alarm".

31. **"issue an alert"** is disclosed by Mitchell at abstract "set off the alarm".

32. **Claim 2 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido.   Claim 2

depends from Claim 1 with one additional limitaion.

33. **"limits comprise specified quantifiable limits"** is inherently disclosed by Enokido at

FIG 1 element 9 "DESIGN TABLES", and alternately disclosed by FIG 1 element 6

"FIRST TEST ITEM GENERATION MEANS".

34. **Claim 3 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 3

depends from Claim 1 with one additional limitation.

35. **"web based tool to electronically read the limits"** is disclosed by Enokido at FIG 1

element 2 "DESIGN INFORMATION READING MEANS".

36. **Claim 4 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 4

depends from Claim 1 with one additional limitation.

37. **"creating a sub-routine to automatically compare the analyses output with the**

limits" is disclosed by FIG 1 element 6 "FIRST TEST ITEM GENERATION MEANS".

38. **Claim 5 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 5 depends from Claim 4 with one additional limitation.

39. **"analyses output comprises engineering calculations relevant to the design"** is disclosed by Enokido at FIG 1 element 6 "FIRST TEST ITEM GENERATION MEANS".

40. **Claim 6 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 6 depends from Claim 5 with one additional limitation.

41. **"applying an exceedance detection algorithm"** is disclosed by Enokido at FIG 1 element 6 "FIRST TEST ITEM GENERATION MEANS".

42. **Claim 7 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 7 depends from Claim 6 with one additional limitation.

43. **"indicates if an exceedance of a computer model engineering calculation is greater than the limits"** is disclosed by Enokido at FIG 1 element 8 "TEST SPECIFICATION WRITING MEANS".

44. **Claim 8 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 8 depends from Claim 1 with one additional limitation.

45. **"issuing an alert message to a user"** is disclosed by Enokido at FIG 1 element 8 "TEST SPECIFICATION WRITING MEANS".

46. **Claim 9 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 9 depends from Claim 1 with one additional limitation.

47. **"outputting engineering specifications and performance results of the design"** is disclosed by Enokido at FIG 1 element 8 "TEST SPECIFICATION WRITING MEANS".

48. **Claim 10 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 10 is an independent claim with 4 limitations.

49. **"input file containing at least predetermined design practice limits"** is disclosed by Enokido at FIG 1 element 9 "DESIGN TABLES".

50. **"an analysis algorithm for comparing the input file with design criteria to generate an output"** is disclosed by Enokido at FIG 1 element 6 "FIRST TEST ITEM GENERATION MEANS".

51. **"an exceedance algorithm for comparing the output to the predetermined design practice limits"** is disclosed by Enokido at FIG 1 element 6 "FIRST TEST ITEM GENERATION MEANS".

52. **"an alert indicator"** is disclosed by Enokido at FIG 1 element 8 "TEST SPECIFICATION WRITING MEANS". Further, Examiner hereby takes official notice that the use of messages such as "CAUTION" and "WARNING" and "ERROR" are ubiquitous in software programs to indicate exceeding predetermined parameters, and these messages serve as alert indicators.

53. **ALTERNATE REJECTION: Claim 10 is alternately rejected under 35 U.S.C. 102(e)** as being anticipated by Mitchell US Patent 6,323,774 B1, which will be referred to as Mitchell. Claim 10 is an independent claim with 4 limitations.

54. **"input file containing at least predetermined design practice limits"** is disclosed by Mitchell at abstract "processor that includes a program for setting threshold values".

55. **"an analysis algorithm for comparing the input file with design criteria to generate an output"** is disclosed Mitchell at abstract "the threshold value of the system could be preprogrammed...which if exceeded would set off the alarm".

56. **"an exceedance algorithm for comparing the output to the predetermined design practice limits"** is disclosed by Mitchell at abstract "the threshold value of the system could be preprogrammed...which if exceeded would set off the alarm".

57. **"an alert indicator"** is disclosed by Mitchell at abstract "set off the alarm".

58. **Claim 11 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 11 depends from Claim 10 with one additional limitation.

59. "predetermined design practice limits comprise specified quantifiable quantities" is inherently disclosed by Enokido at FIG 1 element 9 "DESIGN TABLES", and alternately disclosed by FIG 1 element 6 "FIRST TEST ITEM GENERATION MEANS".

60. **Claim 12 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 12 depends from Claim 10 with one additional limitation.

61. **"predetermined design practice limits are electronically readable"** is disclosed by Enokido at FIG 1 which shows an arrow going from element 9 "DESIGN TABLES" to element 2 "DESIGN INFORMATION READING MEANS".

62. **Claim 13 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 13 depends from Claim 12 with one additional limitation.

63. "web-based tool to electronically read the predetermined design practice limits" is disclosed by Enokido at FIG 1 element 2 "DESIGN INFORMATION READING MEANS".

64. **Claim 14 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 14 depends from Claim 10 with one additional limitation.

65. "exceedance algorithm comprises a sub-routine to automatically compare the output with the predetermined design practice limits" is disclosed by Enokido at FIG 1 element 6 "FIRST TEST ITEM GENERATION MEANS".

66. **Claim 15 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 15 depends from Claim 14 with one additional limitation.

67. "output comprises engineering calculation relevant to the design" is disclosed by Enokido at FIG 1 element 8 "TEST SPECIFICATION WRITING MEANS".

68. **Claim 16 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 16 depends from Claim 10 with one additional limitation.

69. "indicates when an exceedance of a computer model engineering calculation is greater than the predetermined design practice limitations" is disclosed by Enokido at FIG 1 element 8 "TEST SPECIFICATION WRITING MEANS".

70. **Claim 17 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 17 depends from Claim 10 with one additional limitation.

71. "the alert indicator comprises an alert message issued to a user" is disclosed by Enokido at FIG 1 element 8 "TEST SPECIFICATION WRITING MEANS".

72. **Claim 18 is rejected under 35 U.S.C. 102(e)** as being anticipated by Enokido. Claim 18

depends from Claim 10 with one additional limitation.

73. **"engineering and specifications and performance results of the design"** is disclosed

by Enokido at FIG 1 element 6 "FIRST TEST ITEM GENERATION MEANS".

Conclusion

74. The following US Patent is cited as prior art and should be reviewed carefully by

Applicant before responding to this action:

75. Li US Patent 6,339,837 B1 discloses verification methods for electronic circuit designs.

76. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Eduardo Garcia-Otero whose telephone number is 703-

305-0857. The examiner can normally be reached on Monday through Thursday from

9:00 AM to 7:00 PM.

77. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Kevin Teska, can be reached at (703) 305-9704. The fax phone numbers for
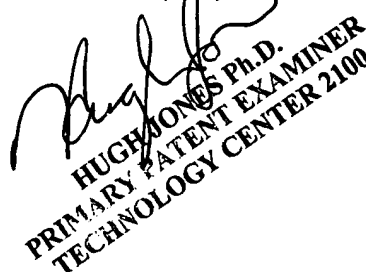
this group are:

78. (703) 746-7238 --- for communications after a Final Rejection has been made;

79. (703) 746-7239 --- for other official communications; and

80. (703) 746-7240 --- for non-official or draft communications.

81. Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the group receptionist, whose telephone number is (703) 305-3900.

* * *